REMARKS

In response to the Office Action mailed March 25, 2005 (hereinafter "Office Action"), claims 2 and 39 have been cancelled without prejudice or disclaimer, and claims 1, 8, 13-14, 20, 23-38, and 40-54 have been amended. No claims have been newly added. Therefore, claims 1, 3-38, and 40-54 are pending. Support for the instant amendments is provided throughout the as-filed Specification. Thus, no new matter has been added. In view of the foregoing amendments and following comments, allowance of all the claims pending in the application is respectfully requested.

INFORMATION DISCLOSURE STATEMENT (I.D.S.)

Applicant is submitting herewith a Supplemental Information Disclosure Statement and respectfully requests that the Examiner consider the cited references and provide a signed copy of the Form PTO-1449 for this submission with the next Office Action.

DRAWINGS

The Examiner notes, at pg. 2, ¶2 of the Office Action, that the application has been filed with informal drawings. Applicant is submitting herewith a set of formal drawings.

SPECIFICATION

A. The Specification has been amended to update related application data.

B. In the Office Action, at pg. 2, ¶3, the Examiner objects to the Specification, alleging that the Abstract, as originally filed, exceeds 150 words. In response, the Abstract has been

amended such that it no longer exceeds 150 words. As such, withdrawal of this objection is earnestly sought.

NON-STATUTORY DOUBLE PATENTING REJECTION

Claims 1, 2, 38, and 51 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1, 2, 3, and 26 of U.S. Patent Application No. 09/524,253. *See* Office Action, pgs. 3, ¶6.

Applicant submits that this rejection is moot for at least the reason that claims 1-26 of U.S. Patent Application Serial No. 09/524,253 were cancelled in an amendment filed in that application on March 29, 2005. Accordingly, withdrawal of this rejection is earnestly sought.

REJECTIONS UNDER 35 U.S.C. §101

Claims 1, 3-38, and 40-54 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. *See* Office Action, pgs. 2, ¶4. Although Applicant disagrees with the rejection of the Examiner and contends that the Examiner is improperly reading limitations into 35 U.S.C. §101 on the subject matter that may be patented, Applicant has amended independent claims 1, 38, and 51 to include the Examiner's suggested claim language. Accordingly, withdrawal of this rejection is earnestly sought.

ALLOWABLE SUBJECT MATTER

Applicant thanks the Examiner for the indication of allowable subject matter. The Examiner has indicated that claims 24-37, 40-50, and 52-54 would be allowable if rewritten

in independent form including all of the limitations of the base claim and any intervening claims. *See* Office Action, pg. 7, ¶10.

REJECTIONS UNDER 35 U.S.C. §103

The Examiner has rejected claims 1-23, 38, 39, and 51 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,073,115 to Marshall in view of U.S. Patent No. 5,608,620 to Lundgren. *See* Office Action, pg. 5, ¶9. Applicant traverses this rejection for at least the reason that the Examiner has failed to establish a *prima facie* case of obviousness.

A. Independent claims 1, 38, and 51.

With regard to independent claims 1, 38, and 51, the rejection is improper because there is no legally proper teaching, suggestion, or motivation to modify Marshall to include the teachings of Lundgren. Assuming arguendo that there was a legally proper teaching, suggestion, or motivation to combine Marshall and Lundgren, the references, even if combined, fail to disclose, teach, or suggest all of the claim elements.

1. There is no legally proper teaching, suggestion, or motivation to modify Marshall to include the teachings of Lundgren.

In the Office Action, at pgs. 5-6, the Examiner alleges that Marshall discloses methods for displaying (simultaneously) information related to financial data in a format selected by the user. The Examiner recites that Marshall does not explicitly teach the remaining features of features of independent claims 1, 38, and 51. The Examiner relies on Lundgren for the missing features, however, alleging that the "*combination of the disclosures taken as a whole suggests that users would have benefited from being able to view data about*

analysts' forecasts in a format they are comfortable with and helped them in their decision making."

This is legally improper. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d (BNA) 1596, 1598-99 (Fed. Cir. 1988). In this case, the Examiner's recited motivation merely states what the alleged combination of the disclosures would suggest, or what "benefit" the combination of the disclosures may provide. In other words, the Examiner has focused on the "result" of the combination of Marshall and Lundgren, but has not provided a legally proper teaching, suggestion, or motivation to combine the two references.

For *at least* this reason, the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, the rejection of claims 1, 38, and 51 is improper and should be withdrawn.

2. Marshall and Lundgren, even when combined, fail to disclose, teach, or suggest all of the elements of claim 1.

Assuming arguendo that Marshall and Lundgren could be combined, the combined references fail to disclose, teach, or suggest all of the elements of claims 1, 38, and 51.

With regard to claims 1 and 38, for example, neither the passages relied upon by the Examiner in Marshall (*e.g.*, Abstract; col. 3, lines 41-48; & claim 1) nor the passages relied upon by the Examiner in Lundgren (*e.g.*, Abstract; FIG. 1; col. 1, lines 21-50; and claim 1), either alone or in combination, disclose the features of displaying simultaneously, on an

analyst by analyst basis, for selected analysts: an indication of historical accuracy for an analyst based on selected criteria; and the analyst's estimate (or recommendation) for a future event. Accordingly, the rejection of claims 1 and 38 is improper and should be withdrawn.

With regard to claim 51, neither the passages relied upon by the Examiner in Marshall (*e.g.*, Abstract; col. 3, lines 41-48; & claim 1) nor the passages relied upon by the Examiner in Lundgren (*e.g.*, Abstract; FIG. 1; col. 1, lines 21-50; and claims 1, 6, 8-11), either alone or in combination, disclose the features of displaying simultaneously, on an analyst by analyst basis, for selected analysts: an indication of historical accuracy for an analyst for one or more securities; current estimate of a future event associated with the analyst for the one or more securities; and model information relating to the analyst. Accordingly, the rejection of claim 51 is improper and should be withdrawn.

For *at least* each of the foregoing reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, independent claims 1, 38, and 51 are patentable over Marshall in view of Lundgren. Dependent claims 3-23 are allowable because they depend from allowable independent claim 1, as well as for the further limitations they contain.

B. Dependent claims 3-23.

Applicant traverses the Examiner's unsupported contention (*see* Office Action, pg. 7) that the features of claims 3-23 are old and well known in the art. The Examiner alleges that it would have been obvious to include the features of claims 3-23 with the combined disclosures of Lundgren and Curtis because the "*combination of the disclosures taken as a whole suggests that users would have benefited from being able to view time series data*

about analysts' forecasts in their preferred format and helped them in their decision making."

Aside from providing a motivation that appears to based merely on what "benefit" the combination of the disclosures may provide, the Examiner has provided no evidence to support the contention that the features of any of claims 3-23 are old and well known in the context of the system and method disclosed and claimed by Applicant. Accordingly, having provided no evidentiary support for the rejection of any of dependent claims 3-23, the Examiner's rejection of these claims is improper and should be withdrawn.

CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: **June 27, 2005**

Respectfully submitted,

By: _____

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